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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/963,299	11/03/97	CHAO D	CONT1000CIPM

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EXAMINER	
DANG, H	
ART UNIT	**PAPER NUMBER**
2873	7

DATE MAILED: 11/12/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
08/963,299	Chao et al.
Examiner	**Group Art Unit**
Hung Dang	2873

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1-46 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-46 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 11 9(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____.

Attachment(s)

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

☐ Interview Summary, PTO-413

☒ Notice of References Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☒ Notice of ~~Draftsperson's Patent Drawing Review,~~ substitute PTO-948

☐ Other _____

Office Action Summary

Oath/Declaration

1. The declaration filed 3/27/98 is acceptable.

Title

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Information Disclosure Statement

3. The Information disclosure Statement filed on 6/8/98 has been considered.

Claim Rejections under 35 USC - 112

4. Claims 9, 11-17, 37 and 38 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 is **inconsistent** with claim 2. Claim 2 recites that the coupling occurs at a coupling surface on the second frame that is substantially perpendicular to the frontal plane. Claim 9 recites that the angle between the coupling surface and the

frontal plane is approximately between 135 degrees and 45 degrees, which make this claim inconsistent and confusing.

In claims 11, 37 and 38, "can be" is in futuro. It is unclear as to what are the metes and bounds of the claimed invention without a distinct definition of what the claimed invention is, as opposed to what it "can be" (or may be).

Correction is required.

Claims Rejection Under 35 USC - 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 6-8, 10, 18-21, 23-28, 30-35 and 37-46 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by **Chao** (5,737,054).

Chao discloses auxiliary lenses for eyeglasses which comprises a primary and an auxiliary spectacle frames for supporting lenses. The primary spectacle frame includes a magnetic connector member secured in the middle bridge portion. The auxiliary spectacle frame includes a middle portion having a

projection for engaging over the middle bridge portion of the primary spectacle frame and having a magnetic connector member for engaging with the connector member of the primary spectacle frame.

Claims Rejection Under 35 USC - 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 5, 22, 29 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Chao** (5,737,054).

Chao discloses auxiliary lenses for eyeglasses which comprises a primary and an auxiliary spectacle frames for supporting lenses. The primary spectacle frame includes a magnetic connector member secured in the middle bridge portion. The auxiliary spectacle frame includes a middle portion having a projection for engaging over the middle bridge portion of the primary spectacle frame and having a magnetic connector member

for engaging with the connector member of the primary spectacle frame.

Chao does not discloses the magnetic member at the bridge of the first frame comprises two separate parts.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the magnetic member at the bridge of the first frame comprises two separate parts, since it has been held that **mere duplication** of the essential working parts of a device involves only routine skill in the art. St. Regis Paper Co. V. Bemis Co., 193 USPQ 8.

Claims Rejection Under 35 USC - 103

7. Claims 11-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Chao** (5,737,054) in view of **Nishioka** (5,642,177).

Chao discloses auxiliary lenses for eyeglasses which comprises a primary and an auxiliary spectacle frames for supporting lenses. The primary spectacle frame includes a magnetic connector member secured in the middle bridge portion. The auxiliary spectacle frame includes a middle portion having a projection for engaging over the middle bridge portion of the primary spectacle frame and having a magnetic connector member

for engaging with the connector member of the primary spectacle frame.

Chao does not discloses the bridge of the auxiliary frame includes a hinge so that the auxiliary frame can be folded.

Nishioka, however, discloses that the auxiliary frame includes a hinge so that the auxiliary frame can be folded

Because Chao and Nishioka are both from the same field of endeavor, the purpose of foldable as disclosed by Nishioka would have been recognized as an art pertinent art of Chao.

It would have been obvious, therefore, at the time the invention was made to a person having skill in the art to construct eyeglasses frame, such as the one disclosed by Chao, with the auxiliary frame includes a hinge so that the auxiliary frame can be folded, such as disclosed by Nishioka for the purpose of foldable.

Claims Rejection, Obviousness Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.

Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-46 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of copending Application No. 08/848,129. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed invention in claims 1-46 of this application is substantially the same as that in claims of the '129 application. All the limitations in claims 1-46 of this application is included in the '129 application and have the same purpose of attaching the auxiliary frame to the primary frame using the magnetic attraction. Thus, the scope of the invention in claims 1-46 of this application is substantially identical to that of claims in the '129 application. Although claims 1-46 of this application does not

claimed the exact the location, shape, size and dimension of the connection between the primary and the auxiliary lens frames as that claimed by '129 application, the location, shape, size, dimension differences are considered obvious design choices and are not patentable unless unobvious or unexpected results are obtained from these changes. It appears that these changes produce no functional differences and therefore would have been obvious.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10. Claims 1-46 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of copending Application No. 08/847,708. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed invention in claims 1-46 of this application is substantially the same as that in claims of the '708 application. All the limitations in claims 1-46 of this application is included in the '708 application and have the same purpose of attaching the auxiliary frame to the primary frame using the magnetic attraction. Thus,

the scope of the invention in claims 1-46 of this application is substantially identical to that of claims in the '708 application. Although claims 1-46 of this application does not claimed the exact the location, shape, size and dimension of the connection between the primary and the auxiliary lens frames as that claimed by '708 application, the location, shape, size, dimension differences are considered obvious design choices and are not patentable unless unobvious or unexpected results are obtained from these changes. It appears that these changes produce no functional differences and therefore would have been obvious.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

11. Claims 1-46 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of copending Application No. 08/847,707. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed invention in claims 1-46 of this application is substantially the same as that in claims of the '707 application. All the limitations in

claims 1-46 of this application is included in the '707 application and have the same purpose of attaching the auxiliary frame to the primary frame using the magnetic attraction. Thus, the scope of the invention in claims 1-46 of this application is substantially identical to that of claims in the '707 application. Although claims 1-46 of this application does not claimed the exact the location, shape, size and dimension of the connection between the primary and the auxiliary lens frames as that claimed by '707 application, the location, shape, size, dimension differences are considered obvious design choices and are not patentable unless unobvious or unexpected results are obtained from these changes. It appears that these changes produce no functional differences and therefore would have been obvious.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

12. Claims 1-46 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of copending Application No. 08/847,710. Although the conflicting claims are not identical, they are not

patentably distinct from each other because the claimed invention in claims 1-46 of this application is substantially the same as that in claims of the '710 application. All the limitations in claims 1-46 of this application is included in the '710 application and have the same purpose of attaching the auxiliary frame to the primary frame using the magnetic attraction. Thus, the scope of the invention in claims 1-46 of this application is substantially identical to that of claims in the '710 application. Although claims 1-46 of this application does not claimed the exact the location, shape, size and dimension of the connection between the primary and the auxiliary lens frames as that claimed by '710 application, the location, shape, size, dimension differences are considered obvious design choices and are not patentable unless unobvious or unexpected results are obtained from these changes. It appears that these changes produce no functional differences and therefore would have been obvious.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

13. Claims 1-46 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of copending Application No. 08/848,101. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed invention in claims 1-46 of this application is substantially the same as that in claims of the '101 application. All the limitations in claims 1-46 of this application is included in the '101 application and have the same purpose of attaching the auxiliary frame to the primary frame using the magnetic attraction. Thus, the scope of the invention in claims 1-46 of this application is substantially identical to that of claims in the '101 application. Although claims 1-46 of this application does not claimed the exact the location, shape, size and dimension of the connection between the primary and the auxiliary lens frames as that claimed by '101 application, the location, shape, size, dimension differences are considered obvious design choices and are not patentable unless unobvious or unexpected results are obtained from these changes. It appears that these changes produce no functional differences and therefore would have been obvious.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

14. Claims 1-46 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of copending Application No. 08/847,709. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed invention in claims 1-46 of this application is substantially the same as that in claims of the '709 application. All the limitations in claims 1-46 of this application is included in the '709 application and have the same purpose of attaching the auxiliary frame to the primary frame using the magnetic attraction. Thus, the scope of the invention in claims 1-46 of this application is substantially identical to that of claims in the '709 application. Although claims 1-46 of this application does not claimed the exact the location, shape, size and dimension of the connection between the primary and the auxiliary lens frames as that claimed by '709 application, the location, shape, size, dimension differences are considered obvious design choices and are not patentable unless unobvious or unexpected results are

obtained from these changes. It appears that these changes produce no functional differences and therefore would have been obvious.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

15. Claims 1-46 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of copending Application No. 08/847,711. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed invention in claims 1-46 of this application is substantially the same as that in claims of the '711 application. All the limitations in claims 1-46 of this application is included in the '711 application and have the same purpose of attaching the auxiliary frame to the primary frame using the magnetic attraction. Thus, the scope of the invention in claims 1-46 of this application is substantially identical to that of claims in the '711 application. Although claims 1-46 of this application does not claimed the exact the location, shape, size and dimension of the connection between the primary and the auxiliary lens frames as

that claimed by '711 application, the location, shape, size, dimension differences are considered obvious design choices and are not patentable unless unobvious or unexpected results are obtained from these changes. It appears that these changes produce no functional differences and therefore would have been obvious.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

16. Any inquiry concerning this communication should be directed to Examiner Dang at telephone number (703) 308-0550.

11/98

HUNG DANG

PRIMARY EXAMINER

TC 2800